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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,830	12/28/2001	Steve Filipski	58165-5001	9704
24574	7590	04/16/2004		
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067				
EXAMINER KRISHNAN, GANAPATHY				
ART UNIT		PAPER NUMBER		
1623				

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/038,830	<b>Applicant(s)</b> FILIPSKI ET AL.	
	<b>Examiner</b> Ganapathy Krishnan	<b>Art Unit</b> 1623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 19-29 is/are pending in the application.  
     4a) Of the above claim(s) 12-17 and 19-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Applicant's election of Group I (claims 1-11) with species identified as Example 2 in the table at page 7 of the specification, in the amendment filed February 3, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 12-17 and 19-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Election was made **without** traverse in the amendment filed February 3, 2004.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonda et al (US 5788954).

Bonda et al teach a composition comprising water 50-80%, sodium hyaluronate 0.001-1%, dimethicone copolyol (a silicone lubricant) 0.01-2%, butylene glycol (a humectant) 0.1-5% (col. 14, lines 10-45 and Example 1 starting at bottom of column 7-8 and ending middle of col. 9-10). This disclosure of Bonda is seen to meet the limitations of instant claims 1-3. The recitation "shaving and moisturizing" is not given patentable weight.

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***Joint Inventors***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonda et al (US 5788954) in combination with Saleh et al (US 6387382) and Flemming et al (US 6117436)

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claim 4 is drawn to a composition comprising about 70-95% water, 2-10% butylene glycol, 0.25-5% dimethicone, 0.01-5% sodium hyaluronate, 0.05-.5% conditioner, 0.1-1.0% preservative and 0.05-0.5% allantoin.

Bonda et al teach a composition comprising water 50-80%, sodium hyaluronate 0.001-1%, dimethicone copolyol (a silicone lubricant and conditioner) 0.01-2%, butylene glycol and glycerol (both humectants) 0.1-5% and 1-10% respectively, panthenol (moisturizer) 0.01-5% and phenonip (a preservative) 0.1-5% (col. 14, lines 10-45 and Example 1 starting at bottom of column 7-8 and ending middle of col. 9-10). The dimethicone in Bonda's composition also functions as a conditioner (see Flemming et al, col. 5, lines 39-41).

However, Bonda et al do not teach a composition comprising allantoin.

Saleh et al teach a composition comprising water 72.9%, hyaluronic acid 0.05%, dimethicone (silicone lubricant) 1.5%, glycerol (a humectant) 3% and allantoin 0.15%. Saleh et al also teach the desirability of allantoin as a component in their composition since it has gives a smooth feeling and is an anti-irritant and also aids in reducing inflammation (col. 9, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the prior art to make a composition comprising the components and percentages as instantly claimed since the percentage and components are seen to be taught in the prior art. Even though Bonda et al teach sodium hyaluronate and Saleh et al teach hyaluronic acid, one of ordinary skill in this art knows that sodium hyaluronate can be substituted for hyaluronic acid.

One of ordinary skill in the art would be motivated to combine the prior art compositions to make a composition comprising allantoin in addition to the other active ingredients since such

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a combination would give a composition which in addition to having a moisturizer, a lubricant, conditioner, preservative and humectant would also have an anti-irritant and anti-inflammatory agent (allantoin). This would give an added benefit in applications of the instant composition.

### ***Conclusion***

1. Claims 1-4 are rejected.

2. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. A composition comprising 0.05-0.1% of chlorphenesin as an active agent in addition to the other agents is neither taught or fairly suggested by the prior art as a whole.

3. Claims 6-11 drawn to compositions comprising chlorphenesin, Canadian Willow herb extracts, licorice extracts, olive leaf extracts and polytetrafluoroethylene with the specific percentage ranges in addition to the other agents recited is neither taught or fairly suggested by the prior art as a whole.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 571-272-0654. The examiner can normally be reached on 8.30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GK

  
SAMUEL BARTS  
PRIMARY EXAMINER  
GROUP 1800